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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/372,750

Applicant(s)

BROWN ET AL.

Examiner

James Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-3, 5-9, 11-18, 20-35 and 37-60 are is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-3, 5-9, 11-18, 20-35 and 37-60 are is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

In their amendment filed 13 May 2003, applicants cancelled claims 4 and 36, amended claims 28, 32, 34, 37, 41, and added claims 49-60.

Claims 2-3, 5-9, 11-18, 20-35 and 37-60 are pending and will be examined.

### ***Response to Arguments***

Applicant's arguments filed 13 May 2003 have been fully considered but they are not persuasive.

Applicants arguments concerning new claims 49-60 and amendments to claims 28, 32, 34, 37 and 41 are addressed more fully in the rejection below.

The Examiner respectfully notes that several arguments and comments presented by applicants fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. For example,

...It is respectfully submitted that these amendments are made *without conceding* the propriety of the Examiner's rejection, but merely to timely advance the prosecution of the present invention...

...Applicants respectfully *disagree* with the Examiner's *combination* of these teachings...

...It is respectfully submitted that Garfinkle fails to cure the deficiencies of the teachings of Enamoto (*assuming these references are combinable, which Applicants do not admit*), as Garfinkle fails to teach or suggest this element of [newly amended] claim 32...  
(emphasis added)

Applicants disagree with the Examiner's combination of Enamoto with knowledge generally available to one of ordinary skill in the art. Applicants argue (a) that shell extensions to facilitate an *order of image-related services* is not

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inherent in a Windows operating system; (b) that it would not have been obvious to combine Enamoto with shell extensions to teach their invention set forth in newly amended claim 28; (c) that it is not well known to incorporate a shell extension to *facilitate the ordering of image-related services*; (d) neither Enomoto nor Garfinkle teaches or suggests an operating system that includes a shell extension for *facilitating an order of image-related services* as recited in claim 28.

As a preliminary matter, the Examiner respectfully notes that the previous rejections *do not* contain the word “inherent” and contain no comments as to what might be inherent in Windows, an operating system introduced by the MICROSOFT Corporation in 1983.<sup>1</sup>

A “traverse” is a denial of an opposing party’s allegations of fact.<sup>2</sup> The Examiner respectfully submits that applicants’ arguments and comments *do not* appear to *traverse* what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants’ arguments and comments as constituting a traverse, applicants’ arguments and comments *do not* appear to constitute an *adequate traversal* because applicant has not specifically pointed out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a).

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<sup>1</sup> Definition of Windows, MICROSOFT Computer Dictionary.

<sup>2</sup> Definition of Traverse, Black’s Law Dictionary, “In common law pleading, a traverse signifies a denial.”

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The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Enamoto and Garfinkle are used to show online ordering services for image related services and products. The Examiner respectfully acknowledges that these references *do not* use the terms "shell" or "shell extension." The Examiner respectfully notes that the rejection stated, in part:

Enomoto discusses the use of disks (see at least Col. 3, lines 21-30). Enomoto discloses other types of disks that may contain image data, including DVD (Digital Video Disc), FD (floppy disk), MO (magneto-optic) and CD (Compact Disc). See at least Col. 8, lines 27-33. These types of disks may contain image files...

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enomoto and well-known file system interfaces (i.e., shell and shell extensions to operating systems) to permit users of personal desktop computers (i.e., applicants' user station) *to access files on a personal desktop computer's disks, such as personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD.*

One of ordinary skill in the art at the time the invention was made would have been *motivated* to combine Enomoto and well-known file system interfaces (i.e., shell and shell extensions to operating systems) and permit PC/desktop users to supply, *via user interfaces, digital image data by accessing files on a personal desktop computer's disks, such as personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD, for the obvious reason* that by including shells and shell extensions to *operating systems such as WINDOWS FILE EXPLORER*, users are provided with convenient, delightful, easy to use interfaces that allow them to manipulate file image data...(emphasis added)

In response to applicant's arguments against the Enamoto and Garfinkle references individually, the Examiner respectfully notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to newly amended claim 32, Applicants state that

It is respectfully submitted that Enamoto fails to disclose *updating* the digital image to the external network entity or another external network entity subsequent to exchanging all ordering information. It is respectfully submitted that Garfinkle fails to cure the deficiencies of the teachings of Enamoto (assuming these references are combinable, which Applicants **do not** admit), as Garfinkle fails to teach or suggest this element of claim 32. (page 10, last paragraph, emphasis added)

The Examiner respectfully notes that the features upon which applicant relies (i.e., "*updating* the digital image to the external network entity...") are not recited in the rejected claim(s) nor in the originally filed disclosures. The claims refer to *uploading* images. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

While applicants appear to concede that the references disclose a digital print order and delivery method and system, applicants appear to argue that Enomoto and Garfinkle fail to disclose updating the digital image to the external network entity or another external network entity subsequent to exchanging all ordering information. The Examiner respectfully submits that Applicants' cites to Enamoto *do not* appear to clarify how their invention differs from Enamoto and that Enamoto is consistent with applicants' disclosures. Applicants disclose uploading digital image data with ordering information. See, for example:

Finally, the NAP module outputs or **uploads** the photographic information **and the order information** so that the network sales server 220, order processing server 222, photofinishing lab 230 and/or the third party fulfillment house 240 can provide a user with photographic images and/or merchandise with the photographic images imprinted thereon. (disclosures, Page 6, lines 17-21).

The shell extension 219 bundles JPEG files of correct resolution **and job number** to a *single* ZIP file and passes *the* file to the NAP module 216. (discl. page 7, lines 13-14).

The network sales serve 220 displays a URL page which describes available services to the consumer 1. The network sales server 220 also displays the thumbnail images as links during the ordering process. The network sales server 220 also provides an interface that assists the consumer 1 **order[present tense]** merchandise for each **uploaded [past tense]** picture and indicates the price information and relevant currency. (disclosures, page 7, line 29-page 8, line 1)

The shell extension 219 bundles into a ZIP file all the files requested at their maximum resolution in JPEG format, **plus other information** saved to the specified directory, and

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passes it to the NAP module 216. The NAP module 216 *uploads the* file to the network sales server 220. (disclosures, page 8, line 25-28).

Please see also previous office action, pages 9-10 for discussion of ordering information and information needed to complete an order.

The Examiner respectfully notes that he has cited particular columns and line numbers in the references as applied to the claims below for applicants' convenience. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicants, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-3, 5-9, 11-18, 20-35 and 37-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enamoto (US 5,974,401) in view of Garfinkle (6,017,157). As a preliminary matter, please note:

#### **All ordering information**

The Examiner respectfully notes that neither reference specifically defines what constitutes "all ordering information," per applicants' latest amendment.

The Examiner respectfully submits that an order is a request to buy, sell, deliver

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or receive goods or services that commits the issuer of the order to the terms specified.<sup>3</sup> For purposes of this examination, Examiner will give the terms "order", "ordering," "ordering information", "all ordering information" their *broadest reasonable* interpretation to read on information sufficient to permit commercial activity to take place.<sup>4</sup>

Enomoto and Garfinkle disclose E-commerce, i.e., commercial activity that takes place by means of computers connected through a network.<sup>5</sup> Both disclose methods, systems, networks, computer programs and signals for on-line *ordering, buying*<sup>6</sup> (cash, credit card, debit accounts) and *selling*<sup>7</sup> image-related goods and services for digital images:

The present invention relates to a method of *ordering and delivering* digital prints and a system therefor, which facilitates *ordering* digital prints and improves efficiency of printing and delivery of the digital prints at *low cost* without lowering print quality. (Enamoto, Col. 1, lines 6-10).

*Orders* for visual prints in various formats corresponding to the photographic image are then *received and fulfilled* from a fulfillment center... (Garfinkle, Col. 2, line 67-Col. 3, line 2).

The establishment which *fulfills, charges and delivers* the *order* will be referred to as the "fulfillment center." (Garfinkle, col. 3, lines 14-16).

"It will be understood that the HTML *interface* is utilized by the photographer 8 in the *sales* process to determine which of the digital images (if any) the photographer would like to *order* as a visual print.

...

When placing an *order*... (Garfinkle, Col. 7, lines 43-60).

In an alternate embodiment, an *order* form can be included with the index print, which the recipient can fill out and return to *place an order* 8d. (Garfinkle, Col. 8, lines 20-37).

### Shells, Shell extensions to operating system

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<sup>3</sup> Definition of Order, Barron's Dictionary of Finance and Investment Terms.

<sup>4</sup> The Examiner respectfully submits that this interpretation is not inconsistent with applicants' note that "...one of ordinary skill in the art can appreciate what other types of information would constitute ordering information." (Amendment C, page 9)

<sup>5</sup> Definition of e-commerce, MICROSOFT Computer Dictionary.

<sup>6</sup> To buy is to acquire property in return for money. Definition of Buy, Barron's Dictionary of Business Terms.

<sup>7</sup> A sale is any exchange of goods or services for money. Definition of Sale, Barron's Dictionary of Business Terms.



The Examiner respectfully notes that neither reference specifically use the terms “operating system”, “shell” or “shell extension”, “shell extension to an operating system” to describe file access and operating system commands. To access files and access system commands, users often use interfaces. An interface is software that enables a program to work with the user (the user interface, which can be a command-line interface, menu-drive interface, or a graphical user interface), with another program such as the operating system, or with a computer’s hardware.<sup>8</sup> Enamoto’s users interact with files and other system resources. Garfinkle discloses use of various *interfaces* to access, upload and download files on a network, including, Interface A, B, HTML.

(a) receiving, at a user station, a digital image

- via digital device interface applications program such as used for scanning images and for digital photography. See at least Col. 1, line 40-Col. 2, line 32 concerning the types of images that may be received and stored at a user station. The user station may run camera/ scanner application programs for supplying image data to a station (see at least Col. 1, line 40-Col. 2, line 32);
- via photo-editing application program(s). See at least Col. 3, lines 41-54; the software carries out different types of formatting and editing of digital images, including image correction, etc. Enomoto also discusses digital device interface applications in image processing programs and software. The

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<sup>8</sup> Definition of interface, MICROSOFT Computer Dictionary.

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programs perform different types of formatting and trimming, i.e., editing, of digital images, including image correction;

- via shell extensions. Enamoto, like Garfinkle, discloses libraries, directories, files and records. Users may access, copy, move, etc. these via extensions (shell extensions) to the operating system. See also previous rejections.

(b) establishing a network connection between a user station and an external network entity

- a network sales/order processing server(s) for receiving an order and for receiving any one a first, second, and third image data image data from a user station after receiving an order (see at least references to order receiver that receives images, order request information and produces prints, Col. 1, lines 51-Col. 2, line 32);
- Enamoto teaches establishing a network connection between client(s) and server network entities. See at least references to connections on networks, including the *Internet*, Col. 3, lines 21-30. See also at least references to web sites, Col. 6, lines 5-15.
- Enamoto discloses using a network access protocol module capable of receiving images, order information and merchandise availability information from an external network entity. See at least Col. 2, lines 40-60, where Enomoto discloses that print sizes and print formats may be available or not available at a fulfillment center such as a photo-finisher.

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- See also references to TCP/IP, a network protocol present on clients and servers that permits communication and transfer of data across the Internet.

(c) accessing an application at the external network entity through the network connection.

- An application is a program or group of programs designed for end users.<sup>9</sup> In Enamoto, see at least references to accessing<sup>10</sup> program(s) at an external network entity via modems (for example, Col. 3, lines 21-30). Applications at the network entity permits the network entity to accept and translate user' signals that will access program(s) at the network entity. See also at least references to software download<sup>11</sup> from an external network entity, Col. 3, lines 41-53, Col. 6, lines 10-18. Downloading software involves accessing, via access program(s), the software file on the network entity. See also references to user ID, which permit a user at a user station to access program(s) on a network entity.
- See also references to the Internet. The Internet, like other client/server environments, has client-side and server-side software program(s). Conventional client/server applications (sometimes called browsers) permit users to access other applications on the external network entity. In

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<sup>9</sup> Definition of Application, Random House Computer and Internet Dictionary.

<sup>10</sup> Access (n.) is the (1) act of reading data from or writing data to memory (2) connection to the Internet or other network or system. Access (v.) is to gain entry to memory in order to read or write data. Definition of Access, MICROSOFT Computer Dictionary.

<sup>11</sup> To download is to copy data from a main source to a peripheral device. Downloading can also refer to copying a file from a network file server to a computer on the network. Definition of download. Computer Internet Dictionary.

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Garfinkle, see also at least references to Web browsers to access Netscape Enterprise Server applications, Col. 5, lines 10-29).

(d) exchanging ordering information, between a user station and an external network entity after accessing the application at the external network entity, for an image-related service for digital images.

- In Enamoto, see at least Col. 2, lines 41-60. See also references to access of applications on the external network entity where those applications calculate print charges and delivery time. For example, Col. 7, lines 4-22). Please note that these activities take place *after* a user at a user station has *accessed the application(s)* at the external network entity.

(e) uploading a digital image to an external network entity or another external network entity subsequent to exchanging all ordering information.<sup>12</sup>

- uploading digital images to servers (including one or more external network entity) subsequent to exchanging ordering information (Col. 2, lines 23-60, which discusses that digital images are sent to an order receiver after order data is received).
- processing an order based on any one of a first, second, and third image data, and outputting any one a first, second, and third image data (see at least Col. 5, lines 43-65, concerning processing of orders and outputting various images);

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- a photofinishing lab for producing photographic-quality print images based on an order and any one a first, second, and third image data from a network sales/order processing server (see at least references to photo-finisher, Col. 3, lines 10-53, Col. 8, lines 42-53).

Enomoto discloses the use of digital photographic image(s) (see at least Col. 2, lines 10-32). Enomoto discloses that users may download and upload image files across networks to facilitate the order of image-related services. While Enomoto does not use the term, a user interfaces with a computer via one or more *interfaces*. Enomoto also discusses the use of applications in image processing programs and software. See at least Col. 3, lines 41-54.

Enomoto discloses that an image-related service generates at least one of photographs and merchandise with photographs imprinted thereon (Col. 5, lines 11-29; Col. 7, lines 53-60; Col. 10, lines 9-27). Enomoto shows that one may first send pre-order data to an order receiver, and follow this by sending image data (see at least Col. 2, lines 40-58). Enomoto discloses various processes for checking and improving quality of digital images, including editing, formatting, image correction, color correction and format (see at least Col. 2, lines 10-32, Col. 3, lines 32-60, which discusses types of editing routines and formatting of digital images). Enomoto teaches the use of PC's/desktops. It is well known that a personal computer is a computer that serves one user; a personal computer

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<sup>12</sup> Please see above for what constitutes all ordering information.

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may be used at home and in the office for almost all applications traditionally performed on large computers.<sup>13</sup> Personal computers have *operating systems*.

An operating system is the master control program that runs a computer; Operating systems such as Macintosh, DOS, Windows are designed for one person at a *desktop computer*. Windows NT, LINUX and UNIX are network operating systems because they are designed to manage multiple user requests at the same time.<sup>14</sup> Operating systems may allow for different shells. For example, DOS, LINUX and UNIX support command-driven interfaces and can host other shells that provide a menu-driven or graphical interface.

Enomoto discusses the use of disks and that disks that may contain image data, including DVD (Digital Video Disc), FD (floppy disk), MO (magneto-optic) and CD (Compact Disc). See at least Col. 3, lines 21-30. See at least Col. 8, lines 27-33. These types of disks may contain image files. A file is a collection of bytes stored as an individual entity. All data on disk is stored as files with assigned file names that are unique within the directory where the file resides.<sup>15</sup> Enomoto discloses the use of libraries (see at least Col. 8, lines 33-41). A library is a collection of programs or data files.<sup>16</sup> Users may access files on various types of disks and libraries via file system interfaces (i.e., shells and shell extensions to operating systems). Different operating systems may use other file

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<sup>13</sup> Definition of Personal Computer. Computer Desktop Encyclopedia. American Management Association. 1996.

<sup>14</sup> Definition of Operating System. Id.

<sup>15</sup> Definition of File. Id.

<sup>16</sup> Definition of Library. Id.

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access interfaces. Windows (which is graphics-based to begin with) allows other shells to provide an interface to a user.<sup>17</sup>

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enomoto and well-known file system interfaces (i.e., shell and shell extensions to operating systems) to permit users of personal desktop computers to access files on a personal desktop computer's disks, such as personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enomoto and well-known file system interfaces (i.e., shell and shell extensions) to permit users of personal desktop computers to access files on a personal desktop computer's disks, including a personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD, for the obvious reason that by including shells and shell extensions such as WINDOWS FILE EXPLORER, users are provided with convenient, delightful, easy to use interfaces that allow them to manipulate file image data. For example, users may copy files from one drive to another via such interfaces. It is well known that users prefer easy-to-use commands and graphical interfaces to manage their files and data. Without such interfaces and extensions, users may feel overwhelmed or frustrated by having to enter obscure, non-intuitive operating system commands. Users who are unable to remember operating system commands may well avoid carrying on electronic commerce over the Internet, for

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<sup>17</sup> Definition of Library. Id.

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example. On the other hand, well-designed, intuitive interfaces permit users to feel comfortable in performing complex operations such as moving a file from a local disk to a network drive. This creates a general feeling of satisfaction, delight and well being and permits users wide use of electronic commerce applications such as ordering customized products that contain images created by users.

Enomoto *does not* use the term "code segment" when describing the different functions of his invention. As noted in prior office actions, it is well known that in computer systems, functions are implemented with computer code. The functions code may be called applications, application programs, programs, modules, applets, executables, load modules, code segments, scripts, etc. Enomoto *does not* specifically name other types of image-related services provided by an order receiver. It is well known to place images, including digital photographic images, on mugs, T-shirts and others.

Therefore, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time the invention was made to apply Enomoto's on-line digital print order and delivery system and include shells and shell extensions to operating systems, code segments for printing digital photographic images on other types of products, including gifts and merchandise.

One of ordinary skill in the art of electronic commerce at the time the invention was made would have been motivated to combine Enomoto's on-line digital print order and delivery system and include shells, shell extensions to operating systems, code segments for printing digital photographic images on



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other types of products, including gifts and merchandise for the obvious reason that customers often enjoy having images of loved ones on T-shirts, cups and other items. Personalization and customization of merchandise greatly enhances customer appreciation for loved ones. There is a great demand for such gifts and products. This benefits commerce because items are sold and purchased.

It is well known that shells and shell extensions of an operating system may be used to access digital images from a file system. With shells, one may access file system commands to move one or more files to/from various directories for use by application programs and interfaces. When software is written, it is common practice to make use of operating system calls for file access and I/O processes, etc. As noted previously, shell programming and extensions are well known in the art and may include e-mail user agent programs that attach files to e-mail messages.

The Internet and WWW are accessible via a network access protocol called Transmission Control Protocol/Internet Protocol, TCP/IP for short. TCP/IP and WWW include a family of *plug-in's*, modules and protocols such as File Transfer Protocol, Telnet. One may include time delays using JAVASCRIPT, JAVA, or their MICROSOFT equivalent. For example, a user may click on a Web page object to initiate actions that may be delayed by applets or JAVASCRIPT.

Users may click on a button of a browser to connect to the Internet, thereby initiating an application at a network access protocol module such as in TCP/IP through an extension (a button on a browser) to an operating system desktop shell interface (e.g., a browser).

Enomoto *does not* discuss the use of plug-in's. Garfinkle discloses the use of file systems and directories. See at least Col. 5, lines 63-67; Col. 6, lines 37-49, describing directories and file such as images stored in JPEG format. Garfinkle describes the use of *plug-in* modules. See at least Col. 5, lines 1-10. See also at least Col. 5, lines 30-67; Col. 6, lines 37-49, describing directories, file systems and addressing schemes to store JPEG and other type of digital images of various resolutions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enomoto and Garfinkle and well known information about the Internet to include accessing multiple images, using shell interfaces and *plug-ins*, and delaying outputting an image and its data to a server until an order for a plurality of images is complete.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enomoto and Garfinkle and well known information about the Internet to include accessing multiple images, using shell interfaces and *plug-ins*, and delaying outputting an image and its data to a server until an order for a plurality of images is complete for the obvious reason that shells, *plug-ins* are widely used on Internet browsers. It is well known and common to delay upload of images and to upload them in batches because of shortened transmission times, reduced utilization of resources.

Enomoto discloses storing images on a user's machine and sending images to a server while sending ordering information to the server. Enomoto *does not* specifically disclose the use of thumbnail images. Enomoto *does not*

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specifically disclose the use of a shell extension of an operating system to access digital image from a file system. Enomoto provides motivation for uploading thumbnail images in that they show that a user may wish to provide pre-order data, including size and quantity information prior to uploading digital images. Thus, Enomoto suggests providing information that would allow a network entity to estimate the cost of fulfilling an order. Thumbnail images are images that correspond to a full image. Thumbnail images are smaller in size than the full image. Thumbnails may be used to provide samples of a finished product in combination with specific images. Garfinkle discloses the use of thumbnail images corresponding to any one of a plurality of images, and sending orders to a network sales/order processing server (see at least Col. 5, lines 10-30, Col. 6, line 56-Col. 7, line 15, Col. 8, lines 8-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enomoto and Garfinkle and disclose the use of thumbnails in a order and fulfillment system. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enomoto and Garfinkle and disclose the use of thumbnails in a order and fulfillment system for the obvious reason that by providing thumbnail images, it is possible for users to see more image data on a screen and focus on the images they select. In addition, by providing thumbnail images, a server may cut down on transmission time and storage prior to selection by a user.

Enomoto discloses displaying on a user station one or more image(s) stored on the local user station. Since thumbnail images are another type of

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image, the combination of Enomoto and Garfinkle disclose displaying one or more thumbnail image(s) and file name(s) on the Internet. Enomoto and Garfinkle *do not use the term pointer to disclose* sending to a server pointer(s) to image(s), including thumbnail images stored on a local user station.

A *pointer* is variable that contains the memory location (address) of some data rather than the data itself.<sup>18</sup> A file name may server as a pointer. On the Internet, a URL provides the logical or physical location of data.<sup>19</sup>

Data may be stored in various types of files and in many formats, including image files (such as JPEG digital photography and thumbnail image files). To access files, users need interfaces. It is well known that one may locate a file by providing a directory name and the file's name within the directory. An operating system shell enables a user to locate and access the data contained in a file, including a digital photography image file and a thumbnail image file.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enomoto, Garfinkle, with knowledge generally available and disclose the use pointers (such as directory name and file name within a directory) to thumbnail images locally stored at a user station.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Enomoto, Garfinkle, with knowledge generally available and disclose the use pointers (such as directory name and file name within a directory) to thumbnail images locally stored at a user station for the

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<sup>18</sup> Definition of Pointer, MICROSOFT Computer Dictionary.

<sup>19</sup> URL is an acronym for Uniform Resource Locator. A URL is an address for a resource on the Internet. Definition of URL, MICROSOFT Computer Dictionary.

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obvious reason that providing pointers to thumbnail images stored on a user station allows a transaction to take place with smaller amounts of information being sent across a network. This decreased exchange of data permits reduced transmission time and reduced bandwidth utilization. All users of an electronic commerce system benefit, since the order information that needs to be sent across networks can be made up of text data exclusively. A list of pointers may be verified more easily at both client and server sites. In addition, a local user need not send image data itself until a full order has been agreed upon.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

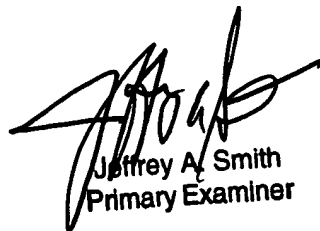
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
June 16, 2003

  
Jeffrey A. Smith  
Primary Examiner

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